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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,843	01/07/2002	James Samsoondar	31773-CIP1	3741

23589 7590 05/19/2005

HOVEY WILLIAMS LLP  
2405 GRAND BLVD., SUITE 400  
KANSAS CITY, MO 64108

EXAMINER
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MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/040,843

Applicant(s)

SAMSOONDAR, JAMES

Examiner

Ardin Marschel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-18, 20, 22, & 29-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-18, 20, 22, & 29-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/1/05 has been entered.

Applicants' arguments, filed 2/1/05, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

### **VAGUENESS AND INDEFINITENESS**

Claims 12-18, 20, 22, and 29-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 12, part iii), a portion or all of the fluid in the first dispensing tip is aspirated into the second dispensing tip. In conflict with the "all" aspiration limitation in said part iii), part iv) of claim 12 cites the dispensing of diluent or reagent into the sealed dispensing tip containing "said fluid". What fluid, being contained in the first tip, is meant in part iv) corresponding to removal, via aspiration, of all of the fluid in the first dispensing tip in part iv)? This conflict is also present in claim 31. Clarification via

clearer claim wording is requested. This issue is also present in claims dependent directly or indirectly from claims 12 or 31 due to their dependence.

### **PRIOR ART**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12, 13, and 16 are rejected under 35 U.S.C. 102(e)(2) as being clearly anticipated by Juranas (P/N 6,368,872).

This rejection is reinstituted due to removal of the “followed by” limitation in claim 12.

Applicant argues that priority should be granted prior to the filing date of Juranas and point to several citations in provisional application 60/078,780 and PCT/CA99/00236. Consideration of the citations pointed to in these documents reveals that neither of them disclose steps iii) or iv) of instant claim 12 and thus these steps of claims dependent therefrom. It is acknowledged that sealing of a first tip is disclosed in said priority documents, however, this is insufficient to provide priority basis for the above listed instant claims due to lacking the disclosure of even one complete embodiment as instantly claimed including said steps iii) and iv). Applicant also incorrectly argues that the instant application is a continuation of PCT/CA99/00236. It is

noted that the instant application is a continuation-in-part of parent 09/664,704 and that 09/664,704 is a continuation of PCT/CA99/00236. Thus, the instant disclosure is a continuation-in-part from PCT/CA99/00236 and not a continuation as alleged by applicant.

Applicant then argues that Juranas does not disclose instant claim 12 steps iii) and iv) by summarizing sections of Juranas. This argument is non-persuasive as not directed to the sections specifically described in support of this rejection in the previous office action, mailed 7/14/04, and thus does not negate them.

Applicant then argues that a nozzle is not a pipette tip. In response applicant also acknowledges the nozzle as being utilized in pipetting. This acknowledgment reasonably is that such a nozzle is a pipette tip thus supporting this rejection. Also, sensors are disclosed in Juranas in column 4, lines 24-27, in nozzle 22 which detects both liquid and the presence of a pipette tip 30 thus supporting this rejection as detection of liquid via sensors in nozzle 22 reasonably indicates that liquid is drawn into nozzle 22 also as in the instant claims. Applicant further argues that this nozzle liquid content would negate the prevention of cross contamination as discussed in Juranas in column 4, lines 15-18. In response column 4, lines 15-18, cites tips and nozzles but lacks any description of cross-contamination prevention. Thus, applicant's argument is an allegation without factual support and thus non-persuasive.

No claim is allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices

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published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., AU 1631 Supervisory Patent Examiner, whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 16, 2005

*Ardin H. Marschel* 5/15/05  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER